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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/722,951      | 11/26/2003  | Ladislav Bednarik    | 022829              | 9628             |

7590 03/21/2006

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EXAMINER

CHEN, VIVIAN

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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1773

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/722,951

Applicant(s)

BEDNARIK ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,9 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 8 and 19-21 is/are allowed.
- 6) ☒ Claim(s) 1-5,9 and 11-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 7, 10 have been cancelled by Applicant.

***Specification***

1. The amendment filed 12/22/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: in claims 2 and 11, the newly added claim limitations encompassing primer coating weights greater than 0.5 lbs.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2-5, 9, 11-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

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claimed invention, for the reasons stated above in the objection to the specification under 35 USC 132(a).

***Claim Rejections - 35 USC § 103***

1. Claims 1, 11-12, 15-17 is rejected under 35 U.S.C. 103(a) as being unpatentable over THOMPSON (US 4,455,184) in view of WILLIAMS (US 6,762,239).

THOMPSON discloses a paperboard substrate, an adhesion promoting layer comprising ethylene vinyl acetate, and an polyethylene terephthalate coating, wherein the polyester has a coating weight as low as 5 lbs/ream and the primer coating has a coating weight as low as 2 lbs/ream, and a method of forming such coated paperboard, wherein the paper is flame treated prior to coating.

WILLIAMS discloses that it is well known in the art to use an adhesive composition comprising ethylene-vinyl acetate functionalized with N-methylol acrylamide and catalyzable with acid catalysts (e.g., ammonium persulfate) for paper coatings. (line 53-65, col. 4; line line 40-60, col. 6; line 12-14, col. 3)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a known EVA adhesive composition as disclosed in WILLIAMS as the adhesion-promoting layer in THOMPSON in order to form solvent-resistant paperboard laminates. It also would have been obvious to utilize conventional clay coated paperboard substrates (claims 4, 15) in the laminates of THOMPSON in order to facilitate coating.

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2. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over THOMPSON (US 4,455,184) in view of WILLIAMS (US 6,762,239), as applied in claim 11, and further in view of HEETER ET AL (US 5,022,554).

HEETER ET AL discloses that it is well known in the art to mist polymer coated paperboard with water in order to improve shaping and forming into articles. (lines 40-61, col. 2; line 43-58, col. 5)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to adjust the amount of water misted (claim 14) depending on the desired flexibility of the coated paperboard.

3. Claims 2, 4-5, 9, 11-12, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over BROCE ET AL (US 2001/0024730).

BROCE ET AL discloses a clay-coated paperboard substrate, an adhesion promoting layer with a typical coating weight as low as 0.5 lb/ream, and a polyethylene terephthalate coating, wherein the polyester has a coating weight as low as 6 lbs/ream, and a method of forming such coated paperboard, wherein the paper is flame treated prior to coating. (paragraphs 0020-0021, 0023-0026, 0035)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a low coating weight adhesion-promoting layer in BROCE ET AL in order to form delamination-resistant PET paperboard laminates.

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4. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over BROCE ET AL (US 2001/0024730), as applied in claim 11, and further in view of HEETER ET AL (US 5,022,554).

HEETER ET AL discloses that it is well known in the art to mist polymer coated paperboard with water in order to improve shaping and forming into articles. (lines 40-61, col. 2; line 43-58, col. 5)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to adjust the amount of water misted (claim 14) depending on the desired flexibility of the coated paperboard.

#### ***Allowable Subject Matter***

1. Claims 8, 19-21 are allowable over the prior art of record.
2. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fail to disclose polyester-coated paperboard substrates with the recited primer coating weights and primer composition (claim 8); or a method of forming polyester-coated paperboard substrates utilizing the recited line speed (claim 19).

#### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 17, 2006



Vivian Chen  
Primary Examiner  
Art Unit 1773